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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,071	02/14/2005	Isa Gokce	P69705US0	1733

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EXAMINER

MONDESI, ROBERT B

ART UNIT	PAPER NUMBER
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1652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/501,071

Applicant(s)

GOKCE ET AL.

Examiner

Robert B. Mondesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed February 1, 2007.

Status of the Claims

Claims 1-36 have been canceled. **Claims 37-54** have been added. **Claims 37-54** are currently pending and under examination.

Withdrawal of Objections and Rejections

The objections and rejections not explicitly restated below are withdrawn due to applicants' response in amendment filed February 1, 2007.

New Objection(s) and Rejection(s)

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 54 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to functional fragments/homologue/derivative of TolAIII defined by the amino acid sequence of SEQ ID NO: 13. The claims do not require that the polypeptide possess any particular conserved structure, or other distinguishing

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feature; such as a specific biological activity. Thus, the claims are drawn to a genus of polypeptides that is defined by an unclear functional relationship to TolAIII defined by the amino acid sequence of SEQ ID NO: 13. To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, and any combination thereof. The specification does not identify any particular portion of the structure that must be characteristics of the claimed genus are not described. The only adequately described species is TolAIII defined by the amino acid sequence of SEQ ID NO: 13 and no active variants are disclosed. Accordingly, the specification does not provide adequate written description of the claimed genus.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states, "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed." (See page 1117.) The specification does not it clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116), As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is

part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF' s were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence. Therefore, only TolAIII defined by the amino acid sequence of SEQ ID NO: 13, but not the full breadth of the claim meets the written description provision of 35 U.S.C. 112, first paragraph. Applicant is reminded that *Vas-cath* makes clear that the written description provision of 35 U.S.C. § 112 is severable from its enablement provision.

Claims 37-48 and 51-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 37-48 and 51-54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *in vitro* expression of the recombinant fusion polypeptide of the invention as in **isolated** host cell, does not reasonably provide enablement for *in vivo* expression the recombinant fusion polypeptide of the invention, as in host cell. The specification does not enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The factors to be considered in determining whether undue experimentation is required are summarized in *re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir.1988). The court in *Wands* states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (*Wands*, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the breadth of the claims, (2) the nature of the invention, (3) the state of the prior art, (4) the predictability or unpredictability of the art, (5) the relative skill of those in the art, (6) the amount or direction or guidance presented, (7) the presence or absence of working examples, and (8) the quantity of experimentation necessary. Although the quantity of experimentation alone is not dispositive in a determination of whether the required experimentation is undue, this factor does play a central role. For example, a very limited quantity of experimentation may be undue in a fledgling art that is unpredictable where no guidance or working examples are provided in the specification and prior art, whereas the same amount of experimentation may not be undue when viewed in light of some

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guidance or a working example or the experimentation required is in a predictable established art. Conversely, a large quantity of experimentation would require a correspondingly greater quantum of guidance, predictability and skill in the art to overcome classification as undue experimentation. In *Wands*, the determination that undue experimentation was not required to make the claimed invention was based primarily on the nature of the art, and the probability that the required experimentation would result in successfully obtaining the claimed invention. (*Wands*, 8 USPQ2d 1406). Thus, a combination of factors which, when viewed together, would provide an artisan of ordinary skill in the art with an expectation of successfully obtaining the claimed invention with additional experimentation would preclude the classification of that experimentation as undue. A combination of *Wands* factors, which provide a very low likelihood of successfully obtaining the claimed invention with additional experimentation, however, would render the additional experimentation undue.

1-2 .Breadth of the claims and the nature of the invention..

In regards to the product of the invention and the breadth of the claims the broadest interpretation that applies is A recombinant fusion polypeptide having an N-terminus and a C-terminus, wherein the fusion polypeptide comprises:

(a) a fusion protein partner located towards the N-terminus of the fusion polypeptide, in which the fusion protein partner consists of a TolAIII domain defined by the amino acid sequence of SEQ ID NO: 13; and (b) a non-TolA polypeptide located towards the C-terminus of the fusion polypeptide, in which the non-TolA polypeptide is other than an His tag, wherein the fusion protein partner functions to facilitate higher levels of

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expression of the non-TolA polypeptide in a **host cell** compared with expression in the **host cell** of the non-TolA polypeptide lacking the fusion protein partner.

3-4. The state of prior art and the level of predictability in the art.

The prior art is silent with regards to the *in vivo* use of the product of the invention with regards to expressing the recombinant fusion polypeptide of the invention in a host (such as in gene therapy) and therefore the level of predictability is low.

However the prior art provides ample evidence in regards to the *in vitro* expression of recombinant fusion polypeptides, such as the recombinant fusion protein of the invention, in **isolated** host cells, see Anderluh et al., 2003 cited in the IDS filed October 14, 2004.

5. The relative skill in the art.

The relative skill in the art as it relates to the product of the invention is characterized by that of a M.D. or Ph. D. level individual.

6-7. The amount of guidance present and the existence of working examples.

The amount of guidance present in the specification of the present application in regards to the *in vivo* expression of the recombinant fusion polypeptide of the invention, as in gene therapy, is non-existent.

Applicants have not provided any examples in the present application indicating the *in vivo* expression of the recombinant fusion polypeptide of the invention, as in gene therapy.

Applicants have provided guidance and examples in regards to the *in vitro* expression of the recombinant fusion polypeptide of the invention in an **isolated** host cell, see page 19-20 of the specification of the instant application.

8. The quantity of experimentation necessary.

The amount of experimentation that is required is undue: while the *in vitro* expression of the recombinant fusion polypeptide of the invention in an **isolated** host cell is routine, the *in vivo* expression of the recombinant fusion polypeptide of the invention in instances that lead to a method of gene therapy is not routine and requires more experimentation. Therefore, in view of the overly broad scope of the claims, the lack of guidance and working examples provided in the specification, and the high degree of unpredictability as evidenced by the prior art, undue experimentation would be necessary for a skilled artisan to make and use the entire scope of the claimed invention.

It must be noted that the issue in this case is the breath of the claims in light of the predictability of the art as determined by the number of working examples, the skill level of the artisan and the guidance presented in the instant specification and the prior art of record. The Applicants make and test position is inconsistent with the decisions of *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) where it is stated that "... scope of claims must bear a reasonable correlation to scope of enablement provided by the specification to persons of ordinary skill in the art...". Without sufficient guidance, determination of having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily and improperly extensive

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and undue. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988).

Therefore, for the instant specification to be enabling, it needs to provide direction/guidance regarding gene therapy using the recombinant fusion polypeptide of the invention expression in a human cell.

Absent sufficient guidance/direction one of skill in the art would not be able to practice the claimed invention commensurate in scope with the claims. Thus, for all these reasons, the specification is not considered to be enabling for one skilled in the art to make and use the claimed invention as the amount of experimentation required is undue, due to the broad scope of the claims, the lack of guidance and insufficient working examples provided in the specification and the high degree of unpredictability as evidenced by the state of the prior art, attempting to express the recombinant fusion polypeptide of the invention in a human cell or other non-isolated host cells encompassed by the claimed invention would constitute undue experimentation. Therefore, applicants have not provided sufficient guidance to enable one of skill in the art to make and use the claimed invention in a manner that reasonably correlates with the scope of the claims, to be considered enabling.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 37-54 are rejected under 35 U.S.C. 101 because as written, **Claims 37-54**, do not sufficiently distinguish over cells that exist naturally because the claims do not particularly point out any non-naturally occurring differences between the claimed

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products and the naturally occurring products. In the absence of the hand of man, the naturally occurring products are considered nonstatutory subject matter. See *American Wood v. Fiber Disintegrating Co.*, 90 U. S. 566 (1974); *American Fruit Growers v. Brogdex Co.*, 283 U. S. 1 (1931); *Funk Brothers Seed Co. v. Kalo Inoculant*, 33 U. S. 127 (1948); and *Diamond v. Chakrabarty*, 206 USPQ 193 (1980). The claims should be amended to indicate the hand of the inventor, e.g., by insertion of "isolated" or "purified". See MPEP 21.

Note to applicants: the term "recombinant" is not sufficient to show the hand of man. Genetic recombination is a well-known natural phenomenon.

Conclusion

No claims are allowed

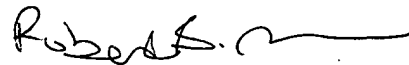
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert B Mondesi
Examiner
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